

REMARKS

Applicants' respectfully request reexamination and reconsideration of the application in view of the following remarks.

Claims 9-10 and 19 have been canceled and claims 1-8, and 11-18, and 20-61 have been amended.

The Examiner has objected to the length of the Abstract.

Applicant respectfully requests that the Examiner withdraw the objection in view of Applicant's amendment to the Abstract in accordance with the Examiner's recommendation.

The Examiner has objected to the specification requiring three spelling error be corrected.

Applicant respectfully requests that the Examiner withdraw the objection in view of Applicant's amendment of the specification.

The Examiner has objected to claims 1-63 under 37 DVF 1.126 because claim some of the claims were misnumbered.

Applicant appreciates that the Examiner renumbered misnumbered claim 12 as 11 and misnumbered claims 14-63 have been renumbered 12-61. Applicant has amended the number of the claims accordingly.

The Examiner has objected to an informality in claim 2.

Applicant respectfully requests that the Examiner withdraw the objection in view of Applicant's amendment of the claim.

The Examiner has objected to an informality in claim 4.

Applicant respectfully requests that the Examiner withdraw the objection in view of Applicant's amendment of the claim.

The Examiner has objected to an informality in claim 39.

Applicant respectfully requests that the Examiner withdraw the objection in view of Applicant's amendment of the claim.

The Examiner has rejected claims 2, 4, 5, 9, 11, 12, 26, 28, 29, 54, 57, and 60 under 35 U.S.C. §112 as being indefinite

Applicant respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the claims in view of the Examiner's comments. Please note that with regard to claims 54-61 the dispersant is added to the neat fluid prior to adding the nanomaterial.

The Examiner has rejected claims 1, 3, 5, 7, 9, 12-16, 18-22, 25-26, 36-37, 45, 49, and 51 under 35 U.S.C. 102(e) as being anticipated by Bonsignore (6,432,320).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the claims and the following remarks..

It is well settled law that a claim is anticipated only if each and every elements as set forth in the claim is found, either expressly or inherently described, in a single prior art reference in as complete detail as is contained in the claim. Moreover, it is not sufficient that the prior art reference disclose all of the elements in isolation. Rather, "[anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Mashchinefabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221

U.S.P.Q. 481,485 (Fed. Cir. 1984) emphasis added). In traversal, the Applicant submits that Wiezbicki et. al. (US 6,014,009),

The Bonsignore reference at column 4, lines 20-50 teach that the nanopowder material is chemically altered by physical adsorption of a chemical agent selected from the group consisting of organic corrosion inhibitors, inorganic corrosion inhibitors, ethylene oxide/polypropylene oxide block copolymers, and combinations thereof as set forth in claim 1 in column 11 on the surface of the powder particles coating the particles contrary to Applicants' claimed composition which suspends the nanomaterial in a stable dispersion and uses none of the coatings.

Moreover, the claims as amended claim selecting a carbon nanomaterial having an aspect ratio of from 500 to 5000 in an effective amount of from 0.001 to 10 percent by weight and adding at least one chemical dispersing agent having a low hydrophile-lipophile balance (HLB) value of 8 or less thereto forming a thermally enhanced fluid, which is not taught nor suggested by the cited reference.

The Examiner has rejected claims 23-24 under 35 U.S.C. 102(e) as being anticipated by Bonsignore (6,432,320) in view of the evidence given by Marquis..

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the independent claim upon which claims 23 and 24 depend and in view of the aforementioned remarks.

The Examiner has rejected claims 11 under 35 U.S.C. 102(e) as being anticipated by Bonsignore (6,432,320) in view of the evidence given by Moy (6,419,717).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the independent claim upon which claims 11 depend and in view of the aforementioned remarks.

The Examiner has rejected claims 1, 4, 6, 38, and 39 under 35 U.S.C. 102(e) as being anticipated by Withers (6,695,974).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to the independent claim upon which claims 1, 4, 6, 38, and 39 depend and in view of the aforementioned remarks. Moreover, Withers teaches the use of a coupling agent which teaches away from Applicant's claimed invention.

The Examiner has rejected claims 8, 27-35, 40-44, 46-48, and 52 under 35 U.S.C. §103 as being unpatentable over Bonsignore in view of Papay (5,652,201).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to independent claim 1 from which all of the cited claims depend and on the following remarks.

Applicant submits that a *prima facie* case of obviousness has not been established because there has been shown no proper teaching, suggestion or motivation modify the cited reference in the manner that has been asserted in the office action to be obvious. Moreover, the Applicant submits that, when properly considered, the only suggestion of the presently claimed invention is provided by the present application.

To establish *prima facie* obviousness of a claimed invention, the Patent Office has the initial burden of identifying in the prior art some teaching, suggestion or motivation to modify the cited references. Furthermore, the prior art must be taken only for what it would teach or suggest to a person of ordinary skill in the art at the time of the invention, without using impermissible hindsight. Moreover, it is impermissible within the framework of Section 103 to pick and choose from any one reference only so much as it will support a given position, to the exclusion of other parts necessary to the full appreciation of what such references fairly suggests to one of ordinary skill in the art. In

re Wesslau, 353 F.2d 238, 241 (CCPA 1965).

The cited reference fails to disclose all of the features recited in Applicants' independent claim 1 deemed necessary to form a stable dispersion of the nanomaterials in solution to be used in lubricant compositions.

The Examiner has rejected claim 2 under 35 U.S.C. §103 as being unpatentable over Withers in view of Moy.

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to independent claim 1 from which claim 2 depends for neither of the reference teach the values of utilizing dispersing agents having an HLB value of less than 8 as claimed by Applicants.

The Examiner has rejected claim 10 under 35 U.S.C. §103 as being unpatentable over Bonsignore in view of Nikolaev (Pub. 2003/0170167).

Applicant respectfully requests that the Examiner withdraw the rejection in view of Applicant's cancellation of claim 10.

The Examiner has rejected claim 17 under 35 U.S.C. §103 as being unpatentable over Bonsignore in view of Moy.

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to independent claim 1 from which claim 17 depends for neither of the reference teach the values of utilizing dispersing agents having an HLB value of less than 8 as claimed by Applicants. Moreover, viscosity is dependent upon more than just particle size.

The Examiner has rejected claims 53,56 and 59 under 35 U.S.C. §103 as being unpatentable over Bonsignore in view of Withers.

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to independent claim 53, 56, and 59 for neither of the references teach the values of utilizing dispersing agents having an HLB value of less than 8 as claimed by Applicants.

The Examiner has rejected claims 54-55, 57-58, and 60-61 under 35 U.S.C. §103 as being unpatentable over Bonsignore in view of Withers and further in view of Tennant (6,099,965).

Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to independent claims 53, 56, and 59 from which the rejected claims depend, for neither of the references teach the values of utilizing dispersing agents having an HLB value of less than 8 as claimed by Applicants.

The Examiner has rejected claim 50 under 35 U.S.C. §103 (a) as being unpatentable over Bonsignore in view of Hoke (4,209,408).

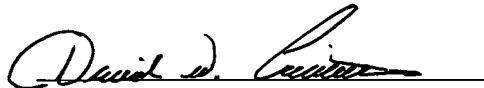
Applicant traverses the rejection and respectfully requests that the Examiner withdraw the rejection in view of Applicant's amendment to independent claim 1 from which the rejected claim depends, for neither of the references teach the values of utilizing dispersing agents having an HLB value of less than 8 as claimed by Applicants.

The Examiner has also listed web sites regarding typical properties of Group II and Group III oils which have been made of record and not relied upon which are considered pertinent to Applicant's disclosure. Applicant has reviewed the references and agrees with the Examiner that while pertinent, the references are no more relevant than the cited references.

For all of the foregoing reasons, Applicant submits that the claims are patentable over the cited references and that the application is in condition for allowance. Accordingly, Applicant respectfully requests prompt reconsideration and receipt of the formal Notice of Allowance. If the Examiner believes there are other unresolved issues in this case, Applicant's attorney would appreciate a telephone call at (502) 452-1233 to discuss any such remaining issues.

Payment for the Petition is enclosed herewith. Please charge any underpayment or credit and overpayments to Counsel's deposit account 50-0642.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "David W. Carrithers", is written over a horizontal line.

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